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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,536	07/27/2001	Kevin Y. Chou	SP01-209	8547

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CORNING INCORPORATED  
SP-TI-3-1  
CORNING, NY 14831

EXAMINER
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SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/916,536

Applicant(s)  
Chou et al.

Examiner  
Rabon Sergeant

Art Unit  
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 15, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above, claim(s) 4, 6, 25, and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-24, 26, and 28-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. Applicants' election without traverse of the species within claims 5, 10, 26, 31, and 46 in Paper No. 6, filed October 15, 2002 is acknowledged. Accordingly claims 4, 6, 25, and 27 have been withdrawn from consideration, as they are directed to non-elected species.

2. Claims 1-3, 5, 7-24, 26, and 28-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' use of "about" in conjunction with the terms, "more than", "less than" and "at least", renders the claims indefinite. The use of "about" with a numerical value causes the quantity to read on values slightly above or below the recited value; therefore, it is unclear if the recited numerical value is a definitive limit when used with the aforementioned terms. For example, it is unclear if the language, "at least about 5", encompasses values of 4.9.

3. Claims 1-3, 7-24, and 28-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions comprising oligomers derived from the reaction of polypropylene glycol, hydroxyethyl acrylate, and either 4,4'-methylenebis(cyclohexylisocyanate) or isophorone diisocyanate, does not reasonably provide enablement for compositions wherein the oligomer is derived from virtually any polyol soft block. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Applicants have not provided any guidance for the selection and use of components, other than the aforementioned ones, that will yield a coating composition having the claimed properties.

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One of ordinary skill could not practice the claimed invention using components, other than those disclosed by the applicants, without having to resort to undue experimentation.

4. Claims 1-3, 5, 7-24, 26, and 28-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for coating compositions derived from the reaction product of oligomers containing terminal ethylenic unsaturation and ethylenically unsaturated reactive monomers, does not reasonably provide enablement for coating compositions derived from oligomers or monomers lacking ethylenic unsaturation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Applicants have failed to provide enablement for the production of coating compositions which are not derived from the reaction of terminally unsaturated oligomers and ethylenically unsaturated monomers, and the position is taken that the claims should be so limited.

5. Claims 1-3, 5, 7-24, 26, and 28-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' means of claiming the composition is confusing, because it is unclear if the oligomer is reacted with the reactive monomer or if the oligomer is derived from the polyol soft block and reactive monomer.

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6. Claims 13-19, 43, and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' use of "comprises" within the claims is confusing; "comprises" is usually used to denote components rather than properties. While a composition "comprises" a component, it "has" a property.

7. Claims 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The relevance, significance, and distinction between the "primary" and "secondary" designations is unclear.

Furthermore, the language set forth within claim 45 does not correspond to the language of related claims 11 and 32; claim 45 requires the monomer itself to be a branched polyoxyalkylene chain, whereas the related claims merely require that the branched component be present with the reactive monomer. It is not clear that the specification provides antecedence for the subject matter of claim 45.

8. Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Firstly, it is unclear if applicants intend "IPDI" and "H12MDI" to denote diisocyanates other than those that correspond to the abbreviations.

Secondly, the language within the third line of the claim is confusing, due to the presence of "in".

Lastly, the language within the third line from the end of the claim is confusing. There appears to be an omission, because the relationship of the reactive monomer is unclear.

9. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Markush group is improper, because "and" should be "or. As drafted, it is unclear if the composition contains one of each of the specified additives or only one of the additives.

10. Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what state the composition is in; if the coating composition of claims 18 and 19 is cured, it is unclear how it can have a viscosity, and if the composition of claims 14-17 is not cured, it is unclear how the composition can have properties that a solid, cured polymer would have.


11. Though claims 6, 27, and 46 contain non-elected species, it is noted that the claims contain oligomers derived from polyols having molecular weights of 2000. These 2000 molecular

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weight polyols fail to further limit the independent claims, which require 4000 molecular weight polyols.

12. In view of the severity of the issues raised under 35 U.S.C. 112, set forth within paragraphs 3, 4, 5, and 8, the position is taken that the ambiguity of the claims precludes further examination on the merits at this time.

Any inquiry concerning this communication should be directed to R. Sargent at telephone number (703) 308-2982.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sargent

December 30, 2002